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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,981	12/13/2000	Kerry Quinn	15966-620 (Cura 120)	5695
7590 12/09/2004			EXAMINER	
Jenell Lawson Intellectual Property CuraGen Corporation 555 Long Wharf Drive New Haven, CT 06551			ULM, JOHN D	
			ART UNIT	PAPER NUMBER
			1646	

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/735,981

**Applicant(s)**

SPADERNA ET AL.

**Examiner**

John D. Ulm

**Art Unit**

1646

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5-10,12-14,19,30,33 and 41 is/are pending in the application.
- 4a) Of the above claim(s) 19 and 41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-10,12-14,30 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/03/04 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/30/01, 10/29/01</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

- 1) Claims 5 to 10, 12 to 14, 19, 30, 33 and 41 are pending in the instant application.
- 2) Claims 19 and 41 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 23 September of 2004. The traversal is on the ground(s) that the "two groups of claims are not distinct because by detecting (claims of Group XXXVI) the nucleic acid (claims of Group XII), Group XXXVI becomes part of Group XII" and "Applicants believes that a search of SEQ ID NO: 7 which encodes the polypeptide of SEQ ID NO: 8 would encompass any references to use for examination of both Groups XII and XXXVI". This is not found persuasive because the text on pages 17 and 18 of the instant specification concedes that the bulk of the sequence information presented in SEQ ID NO:7 and 8 corresponds to a glutamate receptor known in the prior art. The analytical method of invention XXXVI neither makes nor uses the nucleic acid of invention XII and is distinct therefrom because it can be practiced with nucleic acids that were known in the prior art. Further, Applicant's position that a method of detection and a product detected thereby are not distinct defies logic. Would Applicant argue that a radar system and an objected detected therewith are not distinct inventions? That same logic would dictate that a produce scale and a pound of cabbage are patentably indistinct!!!

The requirement is still deemed proper and is therefore made FINAL.

3) This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 C.F.R. § 1.821(a)(1) and (a)(2). However, this clearly application fails to comply with the requirements of 37 C.F.R. § 1.821 through 1.825. Further, claims 7 and 8 do not comply with 37 CFR § 1.822(e) which states that "[a] sequence that is made up of one or more noncontiguous segments of a larger sequence or segments from different sequences shall be presented as a separate sequence".

Applicant needs to provide a computer readable form (CRF) copy of a "Sequence Listing" which includes all of the sequences recited in the claims of the instant application and encompassed by these rules, a paper copy of that "Sequence Listing", an amendment directing the entry of that paper copy into the specification, and a statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. §§ 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d). The instant specification and/or claims will also need to be amended so that they comply with 37 C.F.R. § 1.821(d) which requires a reference to a particular sequence identifier (SEQ ID NO:) be made in the specification and claims wherever a reference is made to that sequence. For rules interpretation Applicant may call (703) 308-1123. See M.P.E.P. 2422.04.

4) The instant specification does not comply with 37 C.F.R. § 1.84(U)(1), which states that partial views of a drawing which are intended to form one complete view, whether contained on one or several sheets, must be identified by the same number followed by a capital letter. Figure 1 of the instant application, **for example**, is

presented on three separate panels. The three sheets of drawings which are labeled "Figure 1" in the instant specification should be renumbered "Figures 1A, 1B and 1C".

Applicant is reminded that once the drawings are changed to meet the separate numbering requirement of 37 C.F.R. § 1.84(U)(1), Applicant is required to file an amendment to change the Brief Description of the Drawings and the rest of the specification accordingly.

5) The text and tables presented on pages 101, 104 to 106, 110 and 111 of the instant specification do not comply with 37 C.F.R. 1.58(c) with respect to font size. 37 C.F.R. 1.58 (c) states that:

Chemical and mathematical formulae and tables must be presented in compliance with § 1.52(a) and (b), except that chemical and mathematical formulae or tables may be placed in a landscape orientation if they cannot be presented satisfactorily in a portrait orientation. Typewritten characters used in such formulae and tables must be chosen from a block (nonscript) type font or lettering style having capital letters which are at least 0.21 cm. (0.08 inch) high (e.g., elite type). A space at least 0.64 cm. (1/4 inch) high should be provided between complex formulae and tables and the text. Tables should have the lines and columns of data closely spaced to conserve space, consistent with a high degree of legibility.

Correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6) Claims 5 to 10, 12 to 14, 30 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims are

vague and indefinite because the limitations "SEQ ID NO:8" and "SEQ ID NO:7" have no clear meaning in the absence of a sequence listing.

6.1) Further, claim 5 is confusing and grammatically incorrect in the recitation of the limitation "an amino acid sequence SEQ ID NO:8". This limitation is confusing because it implies that there is more than one amino acid sequence in SEQ ID NO:8.

6.2) Claims 7 and 8 are confusing because the limitation "splice variant" requires a point of reference and none is given. It is unclear as to what the polypeptide is a "splice variant" of.

6.3) Claim 10 is vague and indefinite because the limitation "hybridizes under stringent conditions" is conditional and no single set of defining conditions is provided.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7) Claim 10 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lamerdin et al. (SPTREMNL-ACC:060391, 01 Aug. 1998, cited by Applicant). The amino acid sequence described by Lamerdin et al. was derived from a nucleic acid that was propagated as a double stranded molecule that would have clearly met the hybridization limitations of the instant claim.

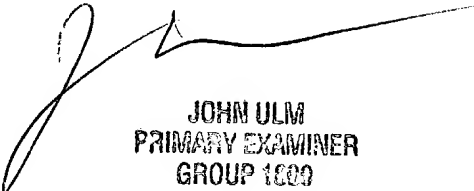
8) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nishi et al., Motoneuron-Specific Expression of NR3B, a Novel

NMDA-Type Glutamate Receptor Subunit That Works in a Dominant-Negative Manner.  
The Journal of Neurochemistry, 2001, Vol.21, RC185, pages 1-6.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Ulm whose telephone number is (571) 272-0880. The examiner can normally be reached on 9:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brunmbach can be reached on (571) 272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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